

**IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION**

ACE LIMITED,)	
)	
Plaintiff,)	
v.)	Case No. 4:14-cv-1068
)	
ACE INSURANCE AGENCY LLC,)	JURY TRIAL DEMANDED
Serve: Ryan Graham)	
Registered Agent)	
6119 Bradley Manor Place)	
St. Louis, MO 63129)	
)	
Defendant.)	

COMPLAINT FOR DAMAGES AND INJUNCTIVE RELIEF

ACE Limited ("ACE Limited"), through its counsel, hereby files this Complaint against Defendant Ace Insurance Agency LLC ("Defendant") for injunctive relief and damages, as follows:

THE PARTIES

1. Plaintiff ACE Limited, a company organized under the laws of Switzerland with its principal place of business at Bäregasse 32, Zurich CH-8001, Switzerland, is the service mark owner and conducts business throughout the United States.
2. Defendant has its principal place of business at 4051 West Outer Road, Arnold, Missouri 63010.

JURISDICTION AND VENUE

3. This Court has original jurisdiction in this matter based on 28 U.S.C. § 1331 in that various of the claims in this case arise under the laws of the United States. Specifically, this

Court has subject matter jurisdiction pursuant to 15 U.S.C. §§ 1114 and 1125 and 28 U.S.C. §§ 1331, 1332 and 1338.

4. This Court has personal jurisdiction over Defendant because, *inter alia*, Defendant transacts business within and has availed itself of this forum; engages in a persistent course of conduct in this forum; expects, or should reasonably expect, its acts to have legal consequences in this forum; and maintains substantial, systematic and continuous contacts in this forum.

5. Venue is proper in the United States District Court for the Eastern District of Missouri pursuant to 28 U.S.C. § 1391(b)(2) in that a substantial part of the events that give rise to the claims occurred in this District and a substantial part of the property that is the subject of this action is situated in this District.

BACKGROUND

ACE Limited's Business and Service Marks

6. ACE Limited provides a broad range of insurance and reinsurance products to its customers through operations in the U.S. and over 50 other countries.

7. ACE Limited has used the mark ACE for its insurance services worldwide since at least as early as 1985, and in the United States since at least as early as 1996.

8. ACE Limited owns numerous federal service mark registrations including the following (the "ACE Marks"):

- **ACE** – US Reg. No. 2,778,828, issued November 4, 2003, with first use in commerce at least as early as August, 1997, for property and casualty insurance underwriting services.
- **ACE** – US Reg. No. 3,177,329, issued November 28, 2006, with first use in

commerce at least as early as May 31, 1998, for insurance services, namely, property and casualty insurance and reinsurance underwriting, claims administration and loss control services, and related financial services, namely, financial guaranty and surety insurance underwriting, mortgage guaranty and guaranty assurance underwriting, and financial risk management services, namely, underwriting credit default swaps, finite risk structures and other financial derivatives and balance sheet protection products.

- **ACE** – US Reg. No. 4,353,311, issued June 18, 2013, with first use in commerce at least as early as 1999, for insurance underwriting services in the fields of boat and yacht insurance; insurance underwriting services in the fields of automobile, home, condominium, vacation, rental property, valuable collections and personal umbrellas.
- **ACE (with logo design)** – US Reg. No. 2,956,379, issued May 31, 2005, with first use in commerce at least as early as April, 1999, for insurance services, namely, underwriting, claims administration and processing services, loss control services, brokerage services, consultation and planning services, risk management services, subrogation and actuarial services, claims adjustment, insurance appraisals, all in the fields of property and casualty insurance and reinsurance; and related financial services, namely, financial guaranty and surety insurance and reinsurance, mortgage guaranty, trade credit and residual value reinsurance, title cover, mortgage guaranty and guaranty assurance underwriting, and financial risk management services, namely underwriting credit default swaps, finite risk structures and other financial derivatives and balance sheet

protection products.

- **ACE ADVANTAGE** – US Reg. No. 2,106,692, issued October 21, 1997, with first use in commerce at least as early as November, 1996, for commercial property and casualty insurance underwriting services.
- **ACE GROUP** – US Reg. No. 3,207,350, issued November 28, 2006, with first use in commerce at least as early as July, 1999, for insurance, namely, property, casualty, accident, health, life and liability insurance and reinsurance underwriting; insurance services, namely, claims administration and processing services, loss control services, brokerage services, consultation and planning services, risk management services, subrogation and actuarial services, claims adjustment, and insurance appraisals, all in the fields of property, casualty, accident, health, life and liability insurance and reinsurance; related financial services, namely, financial guaranty and surety insurance and reinsurance, mortgage guaranty, trade credit and residual value insurance, title cover, asset management, trust account and custodial services, and mortgage guaranty assurance underwriting; and related financial risk management services, namely, underwriting credit default swaps, finite risk structures, financial derivatives, and balance sheet protection products; asset management; and trust account and custodial services.
- **ACE USA** – US Reg. No. 2,947,303, issued May 10, 2005, with first use in commerce at least as early as May 31, 1998, for insurance services, namely, underwriting, claims administration and processing services, loss control services, brokerage services, consultation and planning services, risk

management services, subrogation and actuarial services, claims adjustment, insurance appraisals, all in the fields of property and casualty insurance and reinsurance, and related financial services, namely, financial guaranty and surety insurance underwriting, mortgage guaranty and guaranty assurance underwriting, and financial risk management services, namely underwriting credit default swaps, finite risk structures and other financial derivatives and balance sheet protection products.

True and correct copies of the service mark registrations for the ACE Marks are attached as Exhibit "A".

9. ACE Limited has expended substantial time and effort and hundreds of millions of dollars globally, including the United States of America, to develop and protect the value of the ACE Marks.

10. The ACE Marks are inherently distinctive marks and are widely recognized by the public as source identifiers for Ace Limited's insurance services.

Defendant's Business and Unlawful Conduct

11. Defendant sells insurance services, including personal and commercial insurance.

12. Defendant, without the authorization or consent of ACE Limited, is providing insurance services in connection with the mark ACE. See Screenshot of Defendant's website attached as Exhibit "B".

13. Defendant's unlawful use of the mark ACE is likely to cause confusion in the minds of ACE Limited's actual and potential consumers.

14. Given the confusing similarity of the service marks, reasonable ordinary consumers will mistakenly believe that Defendant's insurance services are sponsored, authorized or approved by ACE Limited.

15. By letter dated June 11, 2013, Counsel for ACE Limited notified Defendant of ACE's prior rights in the ACE Marks and demanded that Defendant cease its infringing activities. Defendant acknowledged receipt of ACE Limited's letter by email on June 12, 2013, but failed to respond to ACE Limited's follow-up emails of June 12, 2013 and August 7, 2013.

16. Defendant's unauthorized conduct constitutes federal trademark infringement and false designation of origin, and causes ACE Limited to suffer irreparable injuries for which it has no adequate remedy at law.

COUNT I

Federal Trademark Infringement, 15 U.S.C. § 1114

17. The allegations of paragraphs 1 through 16 are incorporated herein.

18. Defendant, with knowledge of ACE Limited's ownership of the federally registered ACE Marks, has used the mark ACE in the offer and sale of its own insurance services.

19. Defendant's use in commerce of the valuable ACE Marks is likely to cause confusion, to cause mistake, or to deceive consumers and others regarding the source of the services offered by Defendant.

20. Defendant's actions constitute infringement of ACE Limited's federally registered ACE Marks in violation of 15 U.S.C. § 1114.

21. As a result of Defendant's conduct, ACE Limited has suffered and continues to suffer immediate, irreparable damage for which there is no adequate remedy at law.

COUNT II

Violation of 15 U.S.C. 1125(a);
False Designation of Origin and False Representation

22. The allegations of paragraphs 1 through 21 are incorporated herein.

23. Defendant, with knowledge of ACE Limited's exclusive rights in and to the ACE Marks, and intending to trade on the goodwill and reputation of ACE Limited in the marketplace, has adopted and used the mark ACE in the offer and sale of its own insurance services.

24. Defendant's use of the ACE Marks constitutes a false designation of origin, a false or misleading description of fact, and a false or misleading representation of fact that Defendant's services originate with, are sponsored by or approved by ACE Limited, or that Defendant and its services are affiliated with, connected to, or associated with ACE Limited.

25. Defendant's actions constitute a violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

26. As a result of Defendant's conduct, ACE Limited has suffered, and continues to suffer, immediate, irreparable damage for which there is no adequate remedy at law.

RELIEF SOUGHT

WHEREFORE, ACE Limited demands that:

- A. Judgment be entered in favor of ACE Limited and against Defendant as to each of the above Counts;
- B. Defendant pay damages incurred by ACE Limited as a result of the unlawful acts perpetrated by Defendant;
- C. An accounting be ordered to determine the profits realized by Defendant due to the unauthorized use of the ACE Marks;

- D. Defendant pay three times such profits or damages, whichever is greater;
- E. Defendant, and any officers, directors, agents, servants, employees, representatives, successors, assigns, attorneys, licensees, distributors and all persons in active concert or participation with Defendant, be enjoined from directly or indirectly:
- i. using the ACE Marks or using any confusingly similar designation, alone or in combination with other words, as a trademark, service mark, domain name, or trade name to identify, market, distribute, advertise, promote, to offer for sale or to provide any goods or services;
 - ii. otherwise infringing the ACE Marks;
 - iii. continuing acts of false designation of origin, or doing any acts that may cause Defendant's services to be mistaken for, confused with, or passed off as ACE Limited's services;
 - iv. applying for or attempting to register with any governmental entity, including but not limited to the USPTO, any trademark or service mark consisting in whole or in part of the ACE Marks;
- F. Defendant be directed to file with this Court and to serve on ACE Limited, within ten (10) days after issuance of an injunction, a report in writing, under oath, setting forth in detail the manner and form in which Defendant has complied with the injunction;
- G. Defendant be required to remove the ACE Marks and any confusingly similar name or mark from its website(s) including but not limited to <<http://www.greatace.com>>, all social media hubs, HTML code, search engine query terms, and any other electronic communications hosts, links and devices;

- H. Defendant be ordered to transfer to ACE Limited any domain name consisting, in whole or in part, of the ACE Marks;
- I. Defendant be ordered to pay attorney's fees and costs of this action reasonably incurred by ACE Limited in connection with Defendant's willful acts of trademark infringement and false designation of origin; and
- J. Such other and further relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

ACE hereby demands a trial by jury on all claims that may be tried before a jury.

Respectfully submitted,

CARMODY MacDONALD PC

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